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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91224436
Party	Defendant Sharon Wilson
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Submission	Motion to Dismiss - Rule 12(b)
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Joan Herlong Opposer v. Sharon Wilson Applicant	Opposition No.: 91224436 Serial No.: 86577749 Mark: NUMBER ONE IN THE NEIGHBORHOOD Filed: March 26, 2015

APPLICANT'S COMBINED MOTION TO DISMISS NOTICE OF OPPOSITION AND MOTION TO SUSPEND

Sharon Wilson ("Applicant") moves to dismiss Joan Herlong's ("Opposer") Notice of Opposition ("Notice") for failure to state a claim upon which relief may be granted pursuant to Fed. R. Civ. P. 12(b)(6). As detailed below, Opposer has failed to state a claim that Applicant's mark, NUMBER ONE IN THE NEIGHBORHOOD ("mark"), is deceptively misdescriptive under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1) and of deceptiveness under Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a). Moreover, Opposer has failed to provide anything more than a recitation of the elements of the cause of action which is insufficient pursuant to the *Ashcroft v. Iqbal* pleading standard. For these reasons, Opposer's Section 2(e)(1) claim that the mark is deceptively misdescriptive and Section 2(a) claim of deceptiveness should be dismissed. In addition, Applicant respectfully requests suspension of all proceedings pending disposition of this motion.

I. MOTION TO DISMISS

A. Relevant Factual Background

Applicant's mark has been in use since January of 2005 without complaint. On March 26, 2015, Applicant filed an Application, Ser. No. 86577749, to register the mark in connection

with "real estate agencies" in International class 036. On August 18, 2015, Applicant's mark was published in the Official Gazette.

On October 19, 2015, Opposer filed its Notice regarding Applicant's mark asserting a claim of deceptiveness and that the mark is deceptively misdescriptive. The Notice however, failed to include sufficient facts to support these conclusory allegations. Instead, Opposer merely provided threadbare recitals of the elements and conclusory statements as support for more than one element of the alleged claims. In addition, the facts as pled are insufficient to support the remainder of Opposer's claims. In lieu of an Answer, Applicant files this combined motion to dismiss and suspend.

B. ARGUMENT

The instant motion should be granted because Opposer's Notice fails to state a claim upon which relief may be granted. A motion to dismiss for failure to state a claim upon which relief can be granted tests the legal sufficiency of a complaint. To withstand such a motion, a pleading must allege facts that would, if proved, establish that Opposer is entitled to the relief sought, i.e., that Opposer has standing to maintain the proceeding and that a valid ground exists for opposing the registration. *Young v. AGB Corp.*, 47 USPQ2d 1752, 1755 (Fed. Cir. 1998). *See also* TBMP § 503.02 (3d ed. 2013). The "valid ground" for opposition that must be alleged (and ultimately proved) must be a statutory ground that negates Applicant's right to the subject registration. *Young*, 47 USPQ2d at 1754. For purposes of determining a motion to dismiss, all of Opposer's well-pleaded allegations must be accepted as true, and the complaint must be construed in the light most favorable to Opposer. *Id*.

In *Ashcroft v. Iqbal*, the Supreme Court held "to survive a motion to dismiss, a complaint must contain sufficient factual matter, accepted as true, to 'state a claim to relief that is plausible

on its face.'" *Ashcroft v. Iqbal*, 129 S. Ct. 1937, 1949 (2009) (quoting *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007)). "A claim has facial plausibility when the plaintiff pleads factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged." *Iqbal*, 129 S. Ct. at 1949. "[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements, do not suffice." *Id*. Instead, "[f]actual allegations must be enough to raise a right to relief above the speculative level . . . ." *Twombly*, 550 U.S. at 545. *See also* TBMP Section 309.03(a)(2).

1. **Opposer Has Failed to State a Claim that Applicant's Mark is "Deceptively Misdescriptive" Under Section 2(e)(1), 15 U.S.C. § 1052(e)(1)**

Opposer has failed to state a valid ground for cancellation based on the mark being "deceptively misdescriptive" under Section 2(e)(1) of the Trademark Act. Section 2(e)(1) bars registration on the principal register of a mark that is deceptively misdescriptive of an applicant's goods or services. The Trademark Trial and Appeal Board's test for determining whether or not a term is deceptively misdescriptive under Section 2(e) (1) is as follows:

a. Is the term misdescriptive of the character, quality, function, composition or use of the goods (or services)?

b. If so, are prospective purchasers likely to believe that the misdescription actually describes the goods (or services)?

See In re Berman Bros. Harlem Furniture Inc., 26 USPQ2d 1514 (TTAB 1993); and *In re Quady Winery, Inc.*, 221 USPQ 1213 (TTAB 1984). If a term immediately conveys an immediate idea of an ingredient, quality, characteristic function or feature of the goods or services, and the idea is plausible but false, then the term is deceptively misdescriptive and is unregistrable under §2(e) (1). *See In re Woodward & Lothrop Inc.*, 4 USPQ2d 1412 (TTAB 1987) (CAMEO held

deceptively misdescriptive of jewelry); *In re Ox-Yoke Originals, Inc.*, 222 USPQ 352 (TTAB 1983) (G.I. held deceptively misdescriptive of gun cleaning patches, rods, brushes, solvents and oils).

a. Opposer has failed to plead plausible facts to support that the term NUMBER ONE IN THE NEIGHBORHOOD is misdescriptive of the character, quality, function, composition or use of the services because the term is incapable of being proven true or untrue.

Here, the idea conveyed by Applicant's mark is incapable of being proven true or false and therefore cannot be deceptively misdescriptive no matter the allegations of Opposer. Opposer asserts that Applicant does not have the highest number of sales, Applicant does not have the greatest number of listings, Applicant's listings do not sell faster, Applicant's listings do not sell at a higher price, Applicant's services are not of superior quality, and Applicant's services are not of enhanced performance or function than other agents, in any relevant market, over any relevant time period. Also, Opposer asserts there is no other known, pertinent metric, in any relevant market, over any relevant time period, by which Applicant is the best, most desirable, finest, first, greatest, highest, maximum, paramount, preeminent, superlative, top, ultimate, unsurpassed, utmost, or otherwise "number one" real estate agent. However, none of these assertions, taken as true, establish that Opposer is entitled to the relief sought because Applicant's mark is incapable of being proven false. In order for the mark to be proven true or false, a person would have to determine what NUMBER ONE and NEIGHBORHOOD means in the context of the mark. However, Opposer cannot and will not be able to establish the meaning

of either and thus, Opposer's Section 2(e)(1) claim fails and should be dismissed under Fed. R. Civ. 12(b)(6).

As for NUMBER ONE, there is no metric included in Applicant's mark. Real estate agencies utilize numerous metrics to measure performance. It is therefore unclear which metric, if any at all, is being used to measure what the services are NUMBER ONE at. Opposer has attempted to assert numerous metrics that it claims are "pertinent" but the sheer variety of the metrics listed show that, unless stated in the mark, it is unclear which metric the mark claims Applicant's services are NUMBER ONE at. Therefore, even if Opposer's allegations were taken as true, the mark cannot be proven false. Further, as to NEIGHBORHOOD, there is no indication of what neighborhood Applicant's mark refers to nor the time period measured. Opposer claims Applicant's services are not number one in any pertinent metric "in any relevant market" and "over any relevant time period." However, even the Opposer cannot identify the neighborhood to which the mark is directed. NEIGHBORHOOD could be the Northside, Southside, Eastside or even Mr. Rodgers neighborhood. If the idea that a mark conveys cannot be proven as false, then the mark cannot be deceptively misdescriptive. *See In re Woodward & Lothrop Inc.*, 4 USPQ2d 1412. As a mark cannot be false unless one can determine what the mark references and Applicant's mark is incapable of being proven false, Opposer's claim that the mark is deceptively misdescriptive fails and should be dismissed under Fed. R. Civ. 12(b)(6).

b. Opposer has failed to plead plausible facts to support that prospective purchasers are likely to believe the asserted misdescription describes Applicant's services.

Even if Applicant's mark was capable of being proven false, the Opposer has failed to include any factual allegations that make it plausible that prospective purchasers are likely to believe the misdescription actually describes Applicant's services. Instead, the Opposer merely states "Prospective real estate sellers and purchasers are likely to believe that Applicant's misdescription applies to Applicant's services" (Notice, page 4, ¶9). The Opposer does not assert that anyone actually believes the mark applies Applicant's services. Opposer's statement merely recites a regurgitation of the element of its claim—a pleading tactic expressly rejected by *Twombly*. Because Opposer has failed to assert any plausible facts to support this element, Opposer's claim fails and should be dismissed under Fed. R. Civ. 12(b)(6).

2. **Opposer Has Failed to State a Claim of "Deceptiveness" Under Section 2(a), 15 U.S.C. § 1052(a)**

Opposer has field to state a valid ground for cancellation based on "deceptiveness" under Section 2(a) of the Trademark Act. Section 2(a) bars registration of a mark that consists of or comprises immoral, deceptive, or scandalous matter. The test for determining whether a mark is deceptive under Section 2(a) as:

a. Is the term misdescriptive of the character, quality, function, composition or use of the goods (or services)?

b. If so, are prospective purchasers likely to believe that the misdescription actually describes the goods (or services)?

c. If so, is the misdescription likely to affect the decision to purchase?

See In re ALP of South Beach, Inc., 79 USPQ2d 1009, 1010 (TTAB 2006) (citing *In re Budge Manufacturing Co.*, 857 F.2d 773, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988)). All three questions

must be answered in the affirmative for a mark to be found deceptive under Section 2(a). *American Speech-Language-Hearing Ass'n v. Nat'l Hearing Aid Society*, 224 USPQ 798, 811 (TTAB 1984).

The first two questions of a deceptiveness claim are the same as those of a claim that the mark is "deceptively misdescriptive." As a result, Applicant respectively refers the Board to the earlier analysis regarding these questions and the insufficiency of the allegations pled in Opposer's Notice.

Even if the first two questions could be answered in the affirmative, Opposer has failed to include any factual allegations that make it plausible that the misdescription is likely to affect a potential purchaser's decision to purchase Applicant's services. Instead, the Opposer has provided more conclusory statements and threadbare recitations of elements of its claims, devoid of any plausible facts as required by *Twombly* and *Iqbal*. In particular, Opposer states "Applicant's misdescription is likely to materially affect a significant portion of prospective real estate sellers' and purchasers' decision to procure Applicant's services and would likely be a material factor in the purchasing decision of a significant portion of the relevant consumers of such services." If the mark were deceptive, as alleged, the Opposer should be able to allege some fact, something more than just the conclusory statement, but Opposer cannot and did not. Opposer does not assert any plausible facts that support anyone finding the mark material in their decision to select Applicant's real estate services. As such, Opposer has failed to state a claim of deceptiveness and such claim should be dismissed under Fed. R. Civ. 12(b)(6).

II. MOTION TO SUSPEND

Trademark Rule 2.117 provides that proceedings may be suspended pending disposition of a potentially dispositive motion or upon a showing of good cause. Applicant's motion to

dismiss is potentially dispositive of Opposer's Section 2(e)(1) claim that the mark is "deceptively misdescriptive" and Section 2(a) claim of deceptiveness in this proceeding. Accordingly, Applicant respectfully requests that all proceedings not germane to the motion to dismiss be suspending pending disposition of the motion.

III. CONCLUSION

For the foregoing reasons and authorities, Applicant respectfully requests that its Combined Motion to Dismiss Notice of Opposition and Motion to Suspend be granted.

Respectfully submitted,

November 25, 2015

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Sharon Wilson	)	
	)	
Applicant	)	
_____	)	

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on this 23rd day of Novmber, 2015, a true and correct copy of the foregoing, were served on the following, via electronic mail, and first class mail, postage prepaid.

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